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10/788,677	02/27/2004	Michael D. Smith	418268004US	3591
45979 7590 12/22/2010 PERKINS COIE LLP/MSFT P. O. BOX 1247 SEATTLE, WA 98111-1247				
EXAMINER				
EVANS, KIMBERLY L				
ART UNIT		PAPER NUMBER		
3629				
NOTIFICATION DATE		DELIVERY MODE		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentprocurement@perkinscoie.com

# Office Action Summary

**Application No.**

10/788,677

**Applicant(s)**

SMITH ET AL.

**Examiner**

KIMBERLY EVANS

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 September 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2,5,7-11,22,23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,7-11,22,23, and 25-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Status of Claims**

1. This action is in reply to the application filed on September 24, 2010.
2. Claims 1, 22, and 25 have been amended.
3. Claims 1, 2, 5, 7-11, 22, 23, and 25-29 are currently pending and have been examined.
4. The Examiner has carefully reviewed the Applicants response and has determined that the rejection stands and is resubmitted below addressing the claims as modified by said amendments.

**Claim Rejections - 35 USC § 112 – 2<sup>nd</sup> Paragraph**

5. Examiner maintains the previous 112 – 2<sup>nd</sup> paragraph rejection for claims 7 and 8 since there is insufficient antecedent basis for "the recipient's mail system".

**Claim Rejections - 35 USC § 103**

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
- i. Determining the scope and contents of the prior art.
  - ii. Ascertaining the differences between the prior art and the claims at issue.
  - iii. Resolving the level of ordinary skill in the pertinent art.
  - iv. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 1, 2, 5, 7-11, 22, 23, and 25-29 are rejected under 35 USC 103(a) as being unpatentable over Burrows et al., US Patent Application No US 2004/0093371 A1 in view of Couelgnoux, US Patent Application Publication No US 2006/0053279A1.
9. With respect to Claims 1, and 11,
- Burrows discloses the following limitations,
- *acquiring by the processor, a block of tickets at a time from a ticketing entity, (see at least paragraph 35: "...a Ticket Server provides a network service that can issue "tickets" and can verify and cancel previously issued tickets...") the block of tickets including at least one ticket having a value specified by a sender of a message (see at least paragraph 35: "...A ticket may be implemented as a small binary value (e.g., in the range of about 500 bits), typically represented as a base-64 string so that it can readily be shipped through web pages, URLs, or e-mail messages.....") each ticket of the block including a code from a sequence of codes generated from a start code using a one-way function; (see at least paragraph 35: "...A ticket may be implemented as a small binary value (e.g., in the range of about 500 bits), typically represented as a base-64 string so that it can readily be shipped through web pages, URLs, or e-mail messages.....")*
  - *wherein the message is an electronic mail message*

- *adding the acquired ticket to the message* (see at least paragraph 13: "...If an e-mail message does not have an electronic postage stamp, it will not be allowed into the recipient's mailbox..."); *and forwarding the message with the added ticket to a recipient*, (see at least paragraph 13: "...by adding an easily detectable and verifiable postage stamp, users would be able to filter out e-mail that does not have this postage stamp..."; paragraph 14: "...When sending a message, the message is handed to a delivery agent that communicates with the mail server at the ISP...")
- *wherein upon receiving the message, the recipient can conditionally, redeem the value of the ticket from the ticketing entity* (see at least paragraph 35: "...a request for a new ticket will result in a "challenge" from the Ticket Server; the correct response to this challenge will provide the requestor with the desired ticket. Tickets might have various values, or might be restricted to particular uses. When a ticket has been issued, it can be passed around (for example, with some request or attached to some e-mail). The recipient of a ticket can call the Ticket Server to verify and cancel the ticket, thereby making the originator pay for the request. The recipient can also credit the ticket back to the originator, making the request free.....")

Burrows discloses all of the above limitations, Burrows does not distinctly disclose the following limitations, but Couelgnoux however, as shown discloses,

- *and wherein a mail server is provided with an end code of the sequence of codes and determines whether a ticket of the message includes a code from which the end code can be derived.* (see at least paragraph 27: "...authorized by the receiver's filter, can secretly compute an authorization code unique to the filter, sender pair that it appends to the message sent to the receiver. The receiver's receiving agent can depend on a third party to compute the authorization code independently and compare it to the one produced by the sender's sending agent. If the comparison fails, the message is not displayed to the receiver as intended by the sender ...."; paragraph 62: "...Domain vocabulary 32 and adhoc

vocabulary 33 are lists of codes suitable for helping receiver 2 check the desirability of receiving an email from sender 1..."

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method and systems for reducing spam of Burrows with the method and system of Couelgnoux because the filter process is an efficient means for filtering out undesirable electronic messages.

10. With respect to Claim 2,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *the acquired ticket includes a sender authenticating code so that a mail server that receives the message can authenticate the sender of the message.* (see at least paragraph 289: "...The key K.sub.A authenticates client "A" so that nobody else can acquire tickets charged to A's account..." )

11. With respect to Claim 5,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *wherein the tickets are added to messages in reverse order of generation of their codes.*(see at least paragraph 14: "...When sending a message, the message is handed to a delivery agent that communicates with the mail server at the ISP. Receiving messages is basically the reverse process.....")

12. With respect to Claims 7,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *the recipient's mail system can validate the ticket with the ticketing entity before presenting the message to the recipient* (see at least paragraph 18: "...If a Ticket Kit is issued, the client is able to construct a valid ticket from a correct answer to the challenge and the data in the

Ticket Kit. A challenge is described as possibly including a CPU bound task, a memory bound task, a task that can be solved only by a human, or monetary payment....")

13. With respect to Claim 8,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *the recipient's mail system can automatically discard messages with ticket values below a threshold value set by the recipient.* ( see at paragraph 236: "...if a message arrives not from a white list member and without a ticket, or if the sender's address is invalid (so that no bounce message can be sent), or if an invalid or previously cancelled ticket is provided at any stage, then the ISP 30 silently discards the message. The same is true of messages that exist for too long without a ticket being submitted to the ISP. ...")

14. With respect to Claim 9,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *when the recipient redeems the ticket, an account of the sender is debited.* (see at least paragraph 229: "...Requestors with a positive balance in their account can call the "Request Ticket" operation and will be given a new, valid, unused, ticket without any need to perform a challenge (and their account can be debited). ...")

15. With respect to Claim 10,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *when the recipient redeems the ticket, an account of the sender is credited.* (see at least paragraph 32: "...the centralized service allows the receiver to indicate that a given e-mail is not in fact spam, and so the attached postage should be credited back to the sender.."; paragraph 289: "...The key K.sub.A authenticates client "A" so that nobody else can acquire tickets charged to A's account....")

16. With respect to Claims 22 and 25,

Burrows discloses the following limitations,

- *receiving an electronic message having a ticket issued by a ticketing entity, the ticket having a value that is specified by a sender; (see at least paragraph 13: "...by adding an easily detectable and verifiable postage stamp, users would be able to filter out e-mail that does not have this postage stamp..."; paragraph 35: "...A ticket may be implemented as a small binary value (e.g., in the range of about 500 bits), typically represented as a base-64 string so that it can readily be shipped through web pages, URLs, or e-mail messages.....")*
- *presenting the electronic message to a recipient; when the recipient indicates to redeem the ticket, submitting by the processor the ticket to the ticketing entity for redemption and (see at least paragraph 13: "...If an e-mail message does not have an electronic postage stamp, it will not be allowed into the recipient's mailbox...by adding an easily detectable and verifiable postage stamp, users would be able to filter out e-mail that does not have this postage stamp..."; paragraph 14: "...When sending a message, the message is handed to a delivery agent that communicates with the mail server at the ISP...")*
- *charges the sender for a value of the ticket; and (see at least paragraph 13: "...If an e-mail message does not have an electronic postage stamp, it will not be allowed into the recipient's mailbox...")*
- *when the recipient does not indicate to redeem the ticket, suppressing the redeeming of the ticket so that a recipient can conditionally redeem tickets(see at least paragraph 35: "...a request for a new ticket will result in a "challenge" from the Ticket Server; the correct response to this challenge will provide the requestor with the desired ticket. Tickets might have various values, or might be restricted to particular uses. When a ticket has been issued, it can be passed around (for example, with some request or attached to some e-mail). The recipient of a ticket can call the Ticket Server to verify and cancel the ticket, thereby making the originator pay for the request. The recipient can also credit the ticket back to the originator, making the request free.....")*



- *wherein a sender's account and a recipient's account are maintained by the same entity*
- *wherein a sender's account and a recipient's account are maintained by different entities*  
(see at least paragraph 23: "...An object of embodiments of the present invention is to provide a system and method for automatically accessing all the e-mail accounts of a particular user no matter where hosted.. ...")

Burrows discloses all of the above limitations, Burrows does not distinctly disclose the following limitations but Couelgnoux however as shown discloses,

- *wherein the ticketing entity receives an end code of a sequence of codes and determines whether the ticket includes a code from which the end code can be derived* (see at least paragraph 27: "...authorized by the receiver's filter, can secretly compute an authorization code unique to the filter, sender pair that it appends to the message sent to the receiver. The receiver's receiving agent can depend on a third party to compute the authorization code independently and compare it to the one produced by the sender's sending agent. If the comparison fails, the message is not displayed to the receiver as intended by the sender ...."; paragraph 62: "...Domain vocabulary 32 and adhoc vocabulary 33 are lists of codes suitable for helping receiver 2 check the desirability of receiving an email from sender 1...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method and systems for reducing spam of Burrows with the method and system of Couelgnoux because the filter process is an efficient means for filtering out undesirable electronic messages.

17. With respect to Claim 23,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *wherein the redemption includes decreasing an account balance of the sender and increasing an account balance of the recipient* (see at least paragraph 229: "...whoever receives the ticket and performs the "Cancel Ticket" operation (whether client "B" or the ISP, discussed below in connection with FIG. 2B) can choose to refund the ticket to the originator

by invoking the "Reuse Ticket" operation at the Ticket Server 20. This causes the Ticket Server to credit the ticket to the original requestor's account...")

18. With respect to Claim 26,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *wherein the entity that maintains the sender's account transfers the value to the entity that maintains the recipient's account.* (see at least paragraph 229: "...Finally, whoever receives the ticket and performs the "Cancel Ticket" operation (whether client "B" or the ISP, discussed below in connection with FIG. 2B) can choose to refund the ticket to the originator by invoking the "Reuse Ticket" operation at the Ticket Server 20. This causes the Ticket Server to credit the ticket to the original requestor's account. Requestors with a positive balance in their account can call the "Request Ticket" operation and will be given a new, valid, unused, ticket without any need to perform a challenge (and their account can be debited). ...").

19. With respect to Claim 27,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *the recipient's mail system can validate the ticket with the ticketing entity before presenting the message to the recipient* (see at least paragraph 18: "...If a Ticket Kit is issued, the client is able to construct a valid ticket from a correct answer to the challenge and the data in the Ticket Kit. A challenge is described as possibly including a CPU bound task, a memory bound task, a task that can be solved only by a human, or monetary payment....")

20. With respect to Claim 28,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *wherein the redemption includes decreasing an account balance of the sender and increasing an account balance of the recipient* (see at least paragraph 229: "...whoever

receives the ticket and performs the "Cancel Ticket" operation (whether client "B" or the ISP, discussed below in connection with FIG. 2B) can choose to refund the ticket to the originator by invoking the "Reuse Ticket" operation at the Ticket Server 20. This causes the Ticket Server to credit the ticket to the original requestor's account...")

21. With respect to Claim 29,

Burrows and Couelgnoux disclose all of the above limitations, Burrows further discloses,

- *validating that the ticket can be redeemed before presenting the ticket to the recipient (see at least paragraph 228: "...This operation verifies that the ticket is valid, and that it has not been used before. It then marks the ticket as having been used, and returns to the caller (for example, the recipient of the e-mail) indicating that the operation succeeded...")*

#### **Response to Remarks**

22. Applicant's arguments received September 24, 2010 have been fully considered but they are not persuasive. Referring to Applicant's Remarks, applicant states that "...Because Burrows is only applicable under 35 U.S.C. § 102(e) and was commonly assigned at the time the present application was filed, it cannot be applied under 35 U.S.C. § 103(a). See 35 U.S.C. § 103(c). Thus, claims 1, 2, 5, 7-11 are allowable..." ; Examiner respectfully disagrees.

23. Examiner directs applicant to MPEP 2146[R-3] 35 U.S.C. § 103(c) "... (1) Subject matter developed by another person, which qualifies as prior art **only** (emphasis added) under one or more of subsection (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person..." Even though applicant argues that the Burrows reference cannot be applied under 35 U.S.C. § 103(a) because it was commonly assigned with the instant application

Examiner disagrees. Based upon MPEP 2146[R-3] 35 U.S.C. § 103(c), Burrows reference *also* qualifies as prior art under 35 U.S.C. § 102(a), whereby the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent. The present invention was filed on February 27, 2004 and the Burrows reference was filed on November 8, 2002. Hence, Examiner contends that Burrows reference does in fact qualify as prior art under 35 U.S.C. § 103(a) since it not only qualifies as prior art under 35 U.S.C. § 102(e), but also under 35 U.S.C. § 102(a).

24. Hence, all of the limitations which Applicant disputes as missing in the applied references is fully disclosed or obvious in view of the collective teachings of Burrows and Couelgnoux. Furthermore, Examiner is entitled to give claim limitations their broadest reasonable interpretation in light of the specification. See MPEP 2111[R-1] Interpretation of Claims-Broadest Reasonable Interpretation. During patent examination, the pending claims must be 'given the broadest reasonable interpretation consistent with the specification'. Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re* Prater, 162 USPQ 541,550-51 (CCPA 1969). Burrows teaches a system and method for reducing spam and/or other unwanted behavior on a computer network. Couelgnoux teaches a method and system for controlling electronic messages to include but not limited to filtering. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method and systems for reducing spam of Burrows with the method and system of Couelgnoux because the filter process is an efficient means for filtering out undesirable electronic messages. In view of the above, the Examiner contends that all limitations as recited in the claims have been addressed in this Office Action. For the above reasons, Examiner believes that the rejections in this Office Action are proper. Detailed explanations are given in the preceding sections of the present Office Action.

**Conclusion**

25. **THIS ACTION IS MADE FINAL.** See MPEP 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).
26. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
27. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L. Evans** whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Jami Plucinski** can be reached at **571.272.6811**.
28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or

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faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/KIMBERLY EVANS/Examiner, Art Unit 3629

/Jamisue A. Plucinski/

Supervisory Patent Examiner, Art Unit 3629